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Application No. 10/665,330
Response to Office Action of September 14, 2006

REMARKS/ARGUMENTS

Information Disclosure Statement

Applicants respectfully request reconsideration of the Information Disclosure Statement filed July 6, 2006. Applicants note that the Office has not signed and initialed all pages and references cited on the IDS filed July 6, 2006. Yet, the Office does not mention the reasons for not signing in the outstanding Office Action. Therefore, Applicants are left to assume that the references were not acknowledged due to the fact that no copies of the references were provided by Applicants and that the references were not cited in the parent application. MPEP section 609.04(a)(II)(D) states that the requirement for a copy of each US patent or US patent application publication listed in an IDS had been eliminated unless required by the Office under CFR 1.98(a)(2). However, Applicants respectfully submit that none of the references cited and not acknowledged by the Office fall under the requirements of CFR 1.98(a)(2). Accordingly, the Office should consider these references. Applicants kindly request review and consideration of the references cited in the IDS filed July 6, 2006, and acknowledgement of the same by returning initialed copies of the IDS filed July 6, 2006, to Applicants.

If, for some other reason that is not consistent with Applicants' understanding above, the Office continues to not consider the references cited on the IDS filed July 6, 2006, and acknowledge the same, Applicants kindly request the Office to contact the undersigned by telephone to discuss further so that Applicants may have an opportunity to care to any of the Office's concerns regarding this IDS.

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Rejection(s)

The rejection of Claims 1-4, 7, 9-11, 14-15, and 17 under non-statutory obviousness-type double patenting over claims 1-2 and claims 1-4 of US 6,846,529 and US 6,802,938, respectively, is traversed below.

The Office has issued an obviousness-type double patenting rejection in a series of cases in which not one, but two, Restriction Requirements were issued, made final, and maintained during the prosecution of the ultimate parent application. At the time of the Restriction Requirements dated September 27, 2002, and January 9, 2003, in the parent application US 09/770,340 now US Patent 6,802,938 (US'938), Applicants traversed both restriction requirements. However, the Office decided to make both requirements Final. Accordingly, Applicants relied upon the Office's finality and filed Divisional Application US 10/666,416 now US Patent 6,846,529 (US'529). It should be noted that no non-statutory obviousness-type double patenting rejections over claims 1-4 of US'938 were set forth during the prosecution history of US'529.

Now comes the present divisional application which was filed in reliance of the Office's issuance of not one, but two, restriction requirements during the prosecution of the ultimate parent application now US'938. Now, in the present application, Applicants can not understand why the Office has issued a non-statutory obviousness-type double patenting over claims 1-2 and claims 1-4 of US 6,846,529 and US 6,802,938.

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In addition to all of the above inconsistency, the Office's action of issuing a Restriction Requirement within a Divisional Application is in direct contrast to the statutory law, the MPEP and case law. Section 804.01 of the MPEP clearly outlines the environments in which the Office prohibits the issuance of double patenting rejections.

"The third sentence of 35 U.S.C. 121 prohibits the use of a patent issuing on an application with respect to which a requirement for restriction has been made, or on an application filed as a result of such a requirement, as a reference against any divisional application, if the divisional application is filed before the issuance of the patent."

The situation in the present application and family related thereto is in direct contrast to the above prohibition. Accordingly, the issuance of an obviousness-type double patenting rejection in the present application is in direct violation of the MPEP and statutory law.

The Office sets forth an apparent reasoning for the issuance of the obviousness-type double patenting rejection in the present application by stating that

"because it is claimed now, the paperboard has all the same scope of the board used in the allowed patents" (see page 2, lines 26-27 of the outstanding Office Action).

However, this is merely a statement made in hindsight and is not an acceptable reasoning as outlined by the MPEP in sections 804.01 (A)-(G). MPEP in sections 804.01 (A)-(G) outline the only environments in which the above-mentioned prohibition is does not apply. While

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not being remotely close to the present environment, the closest environment when the above-mentioned prohibition does not apply appears to be MPEP section 804.01 (B):

"(B) The claims of the different applications or patents are not consonant with the restriction requirement made by the examiner, since the claims have been changed in material respects from the claims at the time the requirement was made. For example, the divisional application filed includes additional claims not consonant in scope to the original claims subject to restriction in the parent. Symbol Technologies, Inc. v. Opticon, Inc., 935 F.2d 1569, 19 USPQ2d 1241 (Fed. Cir. 1991) and Gerber Garment Technology, Inc. v. Lectra Systems, Inc., 916 F.2d 683, 16 USPQ2d 1436 (Fed. Cir. 1990). In order for consonance to exist, the line of demarcation between the independent and distinct inventions identified by the examiner in the requirement for restriction must be maintained. 916 F.2d at 688, 16 USPQ2d at 1440."

Applicants direct the Office's attention to Symbol Technologies, Inc. v. Opticon, Inc., 935 F.2d 1569, 19 USPQ2d 1241 (Fed. Cir. 1991) and Gerber Garment Technology, Inc. v. Lectra Systems, Inc., 916 F.2d 683, 16 USPQ2d 1436 (Fed. Cir. 1990) and respectfully submit that the line between the Office's alleged independent and distinct inventions as set forth in the Restriction Requirements dated September 27, 2002, and January 9, 2003, in the parent US'938 has clearly been maintained since the Office's only justification for the restriction between the assembled paper container (claimed in US'529) and methods of making the same (US'938) from the paperboard material presently claimed is that the intermediate product (i.e. the paperboard material) *"is deemed to be useful as a lid for trays and/or other soup containers"* (see the Restriction Requirement dated September 27, 2002). In the case that the Office is correct (Applicants make no comment as to the merits of this position) and the claims of US'529 and US'938 are all of the same scope of the presently

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claimed paperboard material, such a conclusion does not necessarily mean that the presently claimed material can only be used in the claimed assembled paper container of US'938 by only the method of US'529. The Office has not provided any evidence that this original line of demarcation set forth during the prosecution of US'938 has been diminished due to similar scopes of the claims in question. There is no evidence to support the underlying assumption that the presently claimed paperboard material can only be used to make the assembled paper container of US'529 by only the method of US'938. If so, what is the Office's reasoning and evidence supporting such a conclusion and why was there no obviousness-type double patenting rejection issued during the prosecution of US'529 in view of US'938? Clearly there is a double standard being presented by the Office within this family of cases that is in direct contrast to long-established statutory, MPEP and case law prohibitions that are intended to preserve Applicants equity.

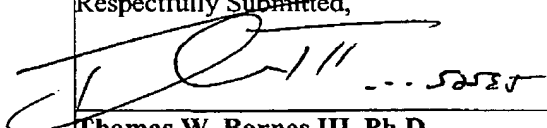
In light of all of the above, Applicants respectfully request that the rejection be withdrawn so that the present claims be allowed to issue as a patent.

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Correspondence Client Number: 01726 (513) 248-6736 (phone) (513) 248-6445 (fax)	Respectfully Submitted, 	
	Thomas W. Barnes III, Ph.D. Registration No.	52,595

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